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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,207	08/01/2001	Brian Craig Lee	10007046-1	5750

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

CARTER, MONICA SMITH

ART UNIT	PAPER NUMBER
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3722

14

DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/920,207

Applicant(s)

LEE, BRIAN CRAIG

Examiner

Monica S. Carter

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### ***Request for Continued Examination***

1. The request filed on August 14, 2003 for a Request for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/920,207 is acceptable and an RCE has been established. An action on the RCE follows.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5-9 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohno et al. ('523).

Ohno et al. disclose a record medium comprising a base layer (2a), at least one magnetic layer (2c) *adapted to* record magnetically encoded information and in contact with the base layer, at least one ink receptive layer (2d) in contact with the at least one magnetic layer, the at least one ink receptive layer *adapted to* absorb ink thereon (see col. 5, lines 9-14). Note: It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. Therefore, the reference applied is only required have the ability to perform the claimed function. In this case, Ohno et al. has

the ability of recording magnetically encoded information and the at least one ink receptive layer has the ability to absorb ink.

Ohno et al. disclose the claimed invention except for explicitly disclosing the at least one magnetic layer comprising a layer of homogenous, magnetic material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired material for the magnetic layer as deemed necessary by the end user, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416.

Ohno et al. disclose the claimed invention except for the at least one ink receptive layer being *adapted to* absorb laser or inkjet ink. It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. Therefore, the reference applied is only required have the ability to perform the claimed function.

Regarding claim 2, Ohno et al. disclose the base layer supporting the magnetic printing media and allowing the magnetic printing media to be transported through the printer (see col. 5, lines 13-14).

Regarding claim 3, Ohno et al. disclose the base layer being capable of being printed on since the base layer is made of plastic and it is well-known in the art that plastic has a printable surface.

Regarding claim 5, see the above rejections to claims 1 and 3.

Regarding claim 6, Ohno et al. disclose the claimed invention except for explicitly disclosing the magnetic material being selected from the group of materials as claimed (one of which being Fe). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired material for the magnetic material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416.

Regarding claims 7 and 8, Ohno et al. disclose the magnetically encoded information comprising text (see col. 3-11).

Regarding claim 9, see the above rejections to claim 1.

Regarding claims 17-19, Ohno et al. inherently disclose the method of making the magnetically encoded printed document in the above rejections.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohno et al. in view of Fryberg et al. ('673).

Ohno et al. disclose the claimed invention except for the at least one ink receptive layer comprising a surface that is coated onto the at least one ink receptive layer to increase the ink receptivity of the surface.

Fryberg et al. disclose recording sheets for ink jet printing wherein the print media is coated with cationic polymers, inorganic pigments, fillers, etc. to increase their ability to absorb ink (see col. 4, lines 34-41). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Ohno's invention

to include a coating on the ink receptive layer that increases ink receptivity, as taught by Fryberg et al., to retain the printing received on the ink surface that would diminish over time without the use of the coating.

5. Claims 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brosow et al. ('032) in view of Ohno et al., as used above.

Brosow et al. disclose magnetic printing media to verify the authenticity of a document comprising a base layer and a layer of magnetizable material. Brosow et al. disclose the claimed invention except for claimed invention except for the particular arrangement of the layers of the magnetic media.

Ohno et al. disclose a recording medium as set forth in the above rejections to claim 1. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Brosow's invention to include a printing media having the above disclosed arrangement, as taught by Ohno et al., to provide a secure document that contains encoded information that can not be easily reproduced.

Brosow et al., as modified by Ohno et al., disclose the claimed invention except for explicitly disclosing the at least one magnetic layer comprising a layer of homogenous, magnetic material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired material for the magnetic layer as deemed necessary by the end user, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of

its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416.

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brosow et al. in view of Ohno et al. and further in view of Fryberg.

Brosow, as modified by Ohno et al., disclose the claimed invention except for the printable surface of the base layer comprising a surface that is coated onto the base layer to increase the ink receptivity of the surface.

Fryberg discloses recording sheets for ink jet printing wherein the print media is coated with cationic polymers, inorganic pigments, fillers, etc. to increase their ability to absorb ink (see col. 4, lines 34-41). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Brosow's invention to include a coating on the base layer that increases ink receptivity, as taught by Fryberg et al., to retain the printing received on the surface that would diminish over time without the use of the coating.

### ***Response to Arguments***

7. Applicant's arguments filed August 14, 2003 have been fully considered but they are not persuasive.

Applicant argues that Ohno et al. fail to disclose an ink receptive layer that absorbs laser or inkjet ink. The examiner maintains that applicant has failed to positively claim this limitation. This limitation has not been positively claimed by applicant since it

is preceded by the term "adapted to". It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. Therefore, the reference applied is only required have the ability to perform the claimed function. Ohno et al. has the ability to perform the claimed function of the ink receptive layer absorbing laser or inkjet ink.

Applicant argues that Fryberg does not cure the deficiencies of Ohno et al. The examiner maintains that Fryberg is used solely for disclosing coating an ink receptive layer and has not been relied upon for disclosing any of the other claimed limitations.

In response to applicant's argument that there is no suggestion to combine the references (Ohno et al. and Fryberg et al.), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Ohno et al. disclose the claimed invention except for providing the at least one ink receiving layer with a coating to increase the ink receptivity of the surface. Fryberg et al. disclose recording sheets for ink jet printing wherein the print media is coated. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Ohno's invention to include a coating on the ink receptive layer, as taught by Fryberg et al., to retain the printing.



In response to applicant's argument that the Ohno et al. and Fryberg et al. references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both references are in the field of applicant's endeavor of media for receiving printing.

In response to applicant's argument that there is no suggestion to combine the references (Brosow et al. and Ohno et al.), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Brosow et al. disclose magnetic printing media that is used to verify the authenticity of a document having a base layer and a layer of magnetizable material. Brosow et al., however, fail to disclose the claimed arrangement of the layers of the magnetic media. Ohno et al. disclose the claimed arrangement of the layers of a magnetic media as set forth above. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to replace the magnetic media of Brosow et al. with the magnetic media of Ohno et al., since it would merely involve replacing one magnetic media for another magnetic media.

Applicant argues that Fryberg does not cure the deficiencies of Brosow et al. and Ohno et al. The examiner maintains the same line of reasoning as set forth above with respect to Ohno et al. and Fryberg.

Note: the remarks with respect to Bauer et al. and Hashiba et al. are moot, since the examiner has withdrawn these references from the rejections.

For the reasons as set forth above, the rejections are maintained.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (7:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



**MONICA S. CARTER  
PRIMARY EXAMINER**

September 16, 2003